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In re Application of :
Paul J. Comay et al : DECISION ON PETITION
Application No. 09/828,296 : UNDER 37 CFR 1.78(a)(3) AND
Filed: April 6, 2001 : UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 5772.02 :

This is a decision on the petition filed July 19, 2004, under 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional application set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the surcharge set forth in 37 CFR 1.17(t);
- (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional; and
- (3) the reference to the prior filed provisional application supplied in an application data sheet (ADS) 37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. See 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5)(i).
The Commissioner may require additional information where there is a question whether the delay was unintentional.

The reference to the, prior-filed provisional application was not included in the manner specified in 37 CFR 1.78(a)(5)(i) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(5)(ii).

The instant petition does not comply with item (3).

The amendment submitted with the instant petition on July 19, 2004, states that the instant application claims priority to Provisional Application No. 60/028,556, filed October 15, 1996. However, this is improper since the instant application was filed on April 6, 2001, which is well over twelve (12) months from the filing of provisional Application No. 60,028,556, filed October 16, 1996. Additionally, it is unclear whether petitioner intends to further claim benefit to provisional Application Nos. 60/215,499 and 60/195,686, since the provisional applications were not included in the amendment filed with the instant petition.

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment along with a renewed petition under 37 CFR 1.78(a)(6), to clarify the above matters is required.

Further correspondence with respect to this matter should be addressed as follows:


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Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.


Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy